

***Advisory Action
Before the Filing of an Appeal Brief***

Application No.

10/018,336

Applicant(s)

LETTMANN, BERNHARD

Examiner

Nathan M. Nutter

Art Unit

1796

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 06 August 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 3, 18, 19, 21, 22, 25, 26, 28 and 42-62.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
With regard to the rejection of claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-62 as failing to comply with the written description requirement under 35 USC 122, first paragraph, there is no disclosure in the Specification of (for (a22)) "optionally, a combination of at least one organic color pigment and at least one inorganic color pigment." The rejection of the claims under 35 USC 122, second paragraph remains since the relationship is vague in view of the recitation for ("a22)." As regards the rejection of claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-62 under 35 USC 103(a) as being unpatentable; e over Reusmann et al taken in combination with Brock et al, applicants argue as though the rejection was made as separate rejections under 35 USC 102. Applicants characterize the prior art as non-analogous. Both references are drawn to coloring systems using modular delivery components, as recited and claimed herein. To employ known modules for their art recognized use in other modular systems of the same art area, here color coating modular systems. It has been held that duplication of the essential working parts of a device involves only routine skill in the art. See *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. The combination of known components used in the identical capacity would be mere manipulation that fails to rise to the level of patentability. It is pointed out that with regard to inclusion of a coloring pigment with a special effects (metallic flake, etc.0 pigment is, indeed, taught as known by Reusmann et al at column 1 (lines 26-30) wherein a fair reading of the cite says, Paints which comprise, in addition to binders, coloring pigments and...special effect pigments." Again, a skilled artisan would be apprised to use both having read that passage. All modules in both references are employed in their art-recognized capacities. Applicants allude to "unexpected results" using an example of their own fabrication, and not prior art references. This is not convincing since there is no comparison with the closest prior art. Further, it is pointed out to applicants the references "significant differences" alleged have not been shown. As pointed out above, the systems are analogous with the instantly claimed invention, and a skilled artisan would know how and why to manipulate the components. The references, considered in their entirety would teach the instantly claimed invention to an artisan having an ordinary skill. Applicants have not shown why the modules are not compatible. Applicants have not shown how the

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